REMARKS

Applicants appreciate the Examiner's attention to the above referenced application. Reconsideration of the application is respectfully requested based on the foregoing amendments and following remarks. Claims 1 to 32 were rejected. Claims 10 and 26 have been cancelled. Claims 1, 5, 11-12, 17, 21, and 27-28 have been amended. Claims 1-9, 11-25 and 27-32 are now pending, of which Claims 1 and 17 are independent.

§ 112 Rejection of the Claims

Claims 1-32 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. This rejection is moot based on the foregoing amendments, and should be withdrawn. It is believed that any issues regarding antecedent basis have been corrected.

§102 Rejection of the Claims

Claims 1, 9, 17, and 25 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Pub. No. 2004/0215544 to Formale et al., (hereinafter "Formale"). Applicants respectfully traverse this rejection, which should be withdrawn for at least the reasons set forth herein.

Independent Claims 1 and 17 have been amended, at least to include the limitations of Claims 10 and 26, respectively. Claims 1 and 17 require a web-based tool configured to select a disposition path, where the disposition path can be selected as any one of *scrapping the surplus item, donating the surplus item, reselling the surplus item, refurbishing the surplus item for reuse, and enabling reuse of the surplus item within the company.* Claims 1 and 17 also require that when the disposition path is enabling reuse of the surplus item <u>within the company</u>, that the web-based tool compares the surplus item to items waitlisted by employees of the company.

Formale does not teach or suggest allowing employees to waitlist an item and a tool that checks for waitlisted items before allowing an employee to order the item. Thus, this rejection should be withdrawn. The Examiner has asserted that this limitation is shown by another reference, and this will be discussed in turn, below.

§103 Rejection of the Claims

Claims 2-4, 6, 18-20, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Formale et al. (U.S. 2004/0215544) in view of Examiner's Official Notice. This rejection is moot based on the above amendments and following discussion, at least as related to amended Claims 1 and 17, and should be withdrawn.

Claims 5 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Formale et al. (U.S. 2004/0215544) in view of Kelly et al. (5,424,944). This rejection is moot based on the above amendments and following discussion, at least as related to amended Claims 1 and 17, and should be withdrawn.

Claims 7 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Formale et al. (U.S. 2004/0215544) in view of Wang (U.S. 2004/0117287). This rejection is moot based on the above amendments and following discussion, at least as related to amended Claims 1 and 17, and should be withdrawn.

Claims 8 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Formale et al. (U.S. 2004/0215544) in view of DeWolf et al. (U.S. 2002/0032626). This rejection is moot based on the above amendments and following discussion, at least as related to amended Claims 1 and 17, and should be withdrawn.

Claims 10-12, 16, 26-28, and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Formale in view of U.S. Pub. No. 2003/0233277 to Saunders et al., (hereinafter, "Saunders"). Applicants respectfully traverse this rejection, which should be withdrawn for at least the reasons set forth herein.

Claims 1 and 17 are amended to include the limitations of Claims 10 and 26. All dependent claims are based on one of these two base claims, so discussion will be focused on amended Claims 1 and 17. As discussed above, amended Claims 1 and 17 require a web-based tool configured to select a disposition path, where the disposition path can be selected as any one of *scrapping the surplus item, donating the surplus item, reselling the surplus item, refurbishing*

the surplus item for reuse, and enabling reuse of the surplus item within the company. Claims 1 and 17 also require that when the disposition path is enabling reuse of the surplus item within the company, that the web-based tool compares the surplus item to items waitlisted by employees of the company.

Neither Formale nor Saunders teach this limitation. Formale does not teach or suggest waitlisting items. The Examiner relies on the teachings of Saunders for this limitation. However, Saunders teaches a method for a retail merchant to provide rainchecks to customers who have typically entered the retail store, only to find that the item is unavailable. The customer must have a store employee enter the raincheck information into the database in order for the raincheck to be activated. The store employee may also alert the customer to viable alternatives to the desired item, at that time.

In contrast, the claimed invention requires that a web-based tool is used for selecting the disposition of a surplus item, by a direct user. The store employee of Saunders is not a direct user of the item. Claims 1 and 17 also recite that the web-based tool is for managing used assets. The raincheck system of Saunders is for managing rainchecks or new items to be purchased by a customer The claimed web-based tool allows the company to select one of a number of disposition paths for the used surplus item. When that disposition is reuse, or reassignment of the used item, the web-based tool compares the item description with previously waitlisted items, where the items have been waitlisted by an employee. Claims 1 and 17 also require that the reuse is to be within the company. This is contrary to the teachings of Saunders. Further, the employee is notified that the item has been put on reserve. The Saunders raincheck system may automatically notify a customer, but not the employee, when the item has been restocked.

The Examiner asserts that Saunders (para. [0003]) teaches placing the surplus item in an on-line public catalogue when a match of a waitlisted item is not found in the on-line tool. However, this cited reference teaches a manual method for applying a physical raincheck to the physical item and maintaining a raincheck box, with paper copies of the items for which rainchecks have been issued. A cursory review of non-cited sections of Saunders does not seem to show this limitation, either. Saunders seems to teach a method for an employee of a retail establishment to enter a raincheck in an electronic database when a customer fills out a paper raincheck form and hands it to a store employee. The employee then enters the raincheck

information into an electronic raincheck system. When the item is restocked, the raincheck is physically attached to the item and the customer is notified by email or telephone.

It will be apparent to those with skill in the art that the Saunders raincheck system solves a different problem than the asset management system of Formale. There is no motivation to combine these methods because they solve different problems. Formale is for managing used corporate assets, and Saunders is for managing out of stock, new, retail assets. Management of used corporate assets requires a different methodology than managing new items for retail purchase, and therefore, combining these references is counterintuitive.

Moreover, a combination of the teachings of Formale and Saunders will not result in the claimed invention, because all limitations are not taught or suggested. As discussed above, Saunders does not provide a method to waitlist a desired surplus, used company owned item, by an employee of the company. Saunders does not place a reusable item in an on-line catalogue to allow an employee to order the surplus item, where the item remains in the catalogue for a predetermined time. Moreover, Saunders does not enable the direct user of the used, surplus item to enter it into an active items list. Instead, Saunders requires a customer to request a raincheck of an employee, who enters the raincheck information into the database. Neither the employee nor the customer are direct users of the item, at least because the item is a new retail item, and not a surplus company asset designated for reuse within the company.

Claims 1 and 17 have been further amended to clarify that the surplus item is to be ordered by an employee, for use within the company, and not for personal use. Saunders does not teach or suggest this sort of waitlisting (raincheck) system. Therefore, there is no *prima facie* evidence of obviousness, and this rejection should be withdrawn.

Claims 13 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Formale et al. (U.S. 2004/0215544) in view of Wiecha (5,870,717) and in further view of Gilberto et al. (U.S. 2003/0158791). This rejection is moot based on the above amendments and foregoing discussion, at least as related to amended Claims 1 and 17, and should be withdrawn.

Claims 14,15,30,31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Formale et al. (U.S. 2004/0215544) in view of Wiecha (5,870,717) and Gilberto et al. (U.S.

2003/0158791), and in further view of Officer (U.S. 2003/0233243). This rejection is moot based on the above amendments and foregoing discussion, at least as related to amended Claims 1 and 17, and should be withdrawn.

CONCLUSION

Applicants respectfully request reconsideration in view of the remarks and amendments set forth above. If the Examiner has any questions, the Examiner is encouraged to contact the undersigned at 703-633-6845. Please charge any shortage of fees in connection with the filing of this paper, including extension of time fees, to Deposit Account 50-0221 and please credit any excess fees to such account.

Respectfully submitted,

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